

Remarks

Claims 1- 3 and 5-44 are pending in the present Application. Claims 1-3 and 5-44 are rejected under 35 U.S.C. §103(b).

Claim 4 has been previously cancelled. Applicant respectfully requests reconsideration and favorable action in this case.

The present invention provides a comprehensive system and method consumer product having specific configuration in an enterprise production pipeline and inventory. The system of the present invention comprise a locate client process, an inventory database, and a locate server process. The locate client process receives product configuration data and generates a search request message incorporating the product configuration data in response to user input. The locate server process receives the search request message from the locate client process, performs a search, and then generates a search reply which is returned to the locate client process. One reason that the current invention is comprehensive is because the inventory database "stores product availability data for products that are on the order bank, being produced, in-transit to distribution facilities, and products at the distribution facilities." (Present Application, claim 1.) The methods of the invention provide the steps by which the system operates.

1. Rejection under 35 U.S.C. §103(b).

Claims 1, 6-7, 10-11, and 17-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,878,401, issued to Joseph ("Joseph") in view of Gignac, "Descartes tracks inventory through cyberspace" ("Gignac"). Applicant respectfully requests reconsideration of the rejection of Claims 1, 6-7, 10-11, and 17-20.

The combination of Joseph and Gignac does not teach the claimed invention as suggested by the Examiner. The Examiner states that Joseph "has taught an online system of locating consumer product having a specific configuration in an enterprise production pipeline and inventory comprising" a locate client process, an inventory database, a locate server process (Office Action, dated November 10, 2003). The Examiner concedes that Joseph does not teach "an inventory database that stores product availability data for products that are on the order bank, being produced, in-transit to distribution facilities, and products at the distribution facilities" (Office Action, dated November 10, 2003). The Examiner uses Gignac to provide this missing element in formulating his rejection under 35 U.S.C. § 103(a).

The combination of Joseph and Gignac may not be used to construct the present invention because neither reference discloses an inventory database (or equivalent step) in which "product availability data for products that are on the order bank, being produced, in-transit to distribution facilities, and products at the distribution facilities" is searched. "Gignac provides a system that "proactively monitors an **order**, identifies whether suppliers are shipping in time, and what the status of a customer's order is as it moves from the supplier to the distributor to the VAR to be configured for a customer." (Gignac, emphasis added.) Gignac (and therefor the combination with Joseph) does not disclose locating a product in such a database. In the present invention, independent claims 1 and 10 do not disclose a method in which an order is tracked as in Gignac. Instead the present invention discloses an online system and method which **locates a product** which a consumer may or may not order. Specifically, Gignac does not teach the utilization of an inventory database as required by independent claim 1. Similarly, Gignac does not teach the analogous database step of claim 10 in which "product availability data associated with products that are on the order bank, in-production, in-transit, and in-inventory for a product matching the product configuration data" is searched.

The combination of Joseph and Gignac does not suggest the present invention. Instead, if Joseph and Gignac are logically combined the resulting method or system would be a method or system for determining if "alternative items for items that are out of stock" were

immediately available (Joseph, col. 1, 60-64.) which tracks an order once a consumer has ordered one of the alternatives. As set forth above, Gignac does not (and accordingly its combination with Joseph) suggest utilization of the comprehensive inventory database of independent claim 1.

Notwithstanding the discussion set forth above. Gignac is merely a survey article and is not enabled with respect to how a monitoring system is implemented. The Federal Circuit has consistently held that prior art references must be enabling:

That prior art patents may have described failed attempts or attempts that used different elements is not enough. **The prior art must be enabling.** See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ 2d 1481, 1489 (Fed. Cir. 1997) ("In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." (quoting *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ 2d 1301, 1304 (Fed. Cir. 1989))).

Rockwell Int'l Corp. v. United States, 47 USPQ 2d 1027, 1032 (Fed. Cir. 1998)

Nowhere in Gignac is the utilization of a database mentioned. A multitude of possibilities not relying on a database exist by which the intended order monitoring functionality of Gignac is achieved. For example, the monitoring might be achieved by an emailing or other messaging system in which a request is sent to each location in the order processing chain for status information regarding the order. Moreover, it would be improper for the Examiner to state that it is inherent to Gignac that a database be used. Such a construction would be inopposite to current law regarding inherency. (See, for example, *Ex parte Schricker*, 56 USPQ 2d 1723, 1725 (B.P.A.I. 2000) (unpublished) which explains "Inherency and obviousness are somewhat like oil and water--they do not mix well.") The Examiner's assertion that Gignac provides such an inventory database is the purest form of hindsight because the Examiner could only have manufactured the use of such a database in Gignac by referring to the present invention.

The Applicant also restates his prior position that Joseph cannot be modified in the manner proposed because Joseph would not tolerate this modification because Joseph teaches away from the proposed modification. Applicant will not restate his previous argument which have been presented in great detail. In summary, Joseph teaches a method in which the goal is to provide immediate alternatives to an item. Accordingly, Joseph does not tolerate searching back ordered items (i.e., products on the order bank.)

Claims 24-37 and 38-44 are rejected for the same reasons as claims 10-23. Accordingly, independent claims 24 and 38 are allowable for the same reasons as set forth above.

Dependent claims 2-3, 11-23, 25-37, and 38-44 each depend from independent claim that has been shown to be allowable. Accordingly, these claim are also allowable. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

Conclusion

Applicant has made a genuine effort to respond to each of the Examiner's rejections in advancing the prosecution of this case. Applicant believes that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If a telephone or video conference would help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

Reply to Office Action of November 10, 2003

The Examiner is authorized to charge \$110.00 of the two-month extension of time fee as a result of the filing of this paper to Ford Global Technologies, Inc.'s Deposit Account No. 06-1510. Enclosed is a check in the amount of \$310.00 to cover the remainder of the two-month extension of time fee.

Respectfully submitted,

Stephen Smith

By James W. Proscia
James W. Proscia
Reg. No. 47,010
Attorney/Agent for Applicant

Date: 4-8-04

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351